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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/621,695	07/21/2000	Yulin Deng	7648.0006	4876
22852	7590	02/06/2004	EXAMINER	
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 1300 I STREET, NW WASHINGTON, DC 20005			WILSON, DONALD R	
			ART UNIT	PAPER NUMBER
			1713	

DATE MAILED: 02/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/621,695

Applicant(s)

DENG ET AL.

Examiner

Donald R Wilson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 26 November 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-9, 13-15 and 18-25 is/are pending in the application.
- 4a) Of the above claim(s) 3, 4, 13-15 and 18-21 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 5-9 and 22-25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

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**DETAILED ACTION**

**Status of Application**

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 11/26/03 has been entered.

2. Applicant's election of the inventions of Group I, now Claims 1-9, 13-15 and 18-25, in Paper No. 4, remains in effect. The further election of the species of

- a. a copolymer of butyl acrylate and 3-methacrylamidopropyltrimethylammonium chloride (MAPTAC) (as in Example 1) as the cationic polymer,
- b. a tacky polymer,
- c. no tackifier present, and
- d. no plasticizer present,

in Papers No. 4 and 12 also remains in effect. Claims 3-4, 13-15 and 18-21 remain withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

3. Claims 1-2, 5-9 and 22-25 are under consideration.

**Response to Amendment**

4. Applicant's amendment filed 11/26/03, has been fully considered with the following results.

5. Applicant is incorrect in stating that,

"In the Advisory Action dated August 13, 2003, the Examiner confirms Applicants' election of a copolymer of butyl acrylate and 3-methacrylamido-propyltrimethylammonium chloride (MAPTAC).

In the Advisory Action, however, the Examiner noted that election of species resulting from the telephone conversation of June 20, 2002, has been treated as an election without traverse."

The Examiner acknowledged applicant's affirmation of said election made in the telephone conversation.

As correctly noted by applicant the restriction requirement and election of species had previously been traversed, and the traversal had been considered and rebutted by the Examiner. As the further election

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of species affirmed in Paper No.12, was not further traversed by applicant, the Examiner's treatment of the election as an election without traverse was proper. Applicant may still further traverse or petition the restriction and election of species, if they so desire.

6. With the amendment to Claim 5, Claims 5-9 now read on the elected specie of the invention and are rejoined with the claims under consideration. Claims 18-19 do not read on the elected specie of polymer as they further require the presence of an uncharged water soluble monomer or macromonomer.

7. Applicant's amendment to Claim 1 overcomes the rejection under 35 U.S.C. § 112, first paragraph, and the rejection is withdrawn. The Examiner will accept that backbone compound may refer to either a backbone monomer or polymer. However, it is noted that the cationic monomer, which becomes a part of the polymer backbone is then also a backbone compound.

8. The amendment is not deemed to be persuasive in overcoming the prior art rejections for reasons discussed below.

#### ***Previously Cited Statutes***

9. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office Action.

#### ***Claim Rejections - 35 USC § 102(b)/§ 103(a)***

10. ***Claims 1-2, 5-9 and 22-25 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Mandeville.*** The basis of this rejection was stated in Detailed Action § 22-23 of the Office Action of 6/28/02, and has been further discussed in Detailed Action § 14 of the Office Action of 2/28/03, and the Advisory Action of 8/13/03.

11. Applicant continues to traverse the rejection repeating and expanding on previous arguments which have not been found to be persuasive. For both the anticipatory and obviousness aspects of the rejection applicant focuses on Mandeville not disclosing that the adhesive or coating is attracted to fibers during paper recycling. However, the limitation, "wherein the adhesive or coating is attracted to fibers during paper recycling" is a property of the claimed adhesive. As previously explained, in as much as the adhesive is the same as that taught by the reference, it is reasonable to expect that it would exhibit the same properties.

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It has been held that where applicant claims a composition in terms of function, property or characteristic where said function is not explicitly shown by the reference and where the examiner has explained why the function, property or characteristic is considered inherent in the prior art, it is appropriate for the examiner to make a rejection under both the applicable section of 35 USC 102 and 35 USC 103 such that the burden is placed upon the applicant to provide clear evidence that the respective compositions do in fact differ. *In re Best*, 195 USPQ 430, 433 (CCPA 1977); *In re Fitzgerald et al.*, 205 USPQ 594, 596 (CCPA 1980).

The continued argument that Mandeville is non-analogous art is not deemed to be persuasive for reasons of record.

12. Claims 1-2, 5-9 and 22-25 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Bister. The basis of this rejection was stated in Detailed Action § 24-25 of the Office Action of 6/28/02, and has been further discussed in Detailed Action § 16 of the Office Action of 2/28/03, and the Advisory Action of 8/13/03.

13. Applicant traverses the rejection on the same basis as is discussed above for the rejection over Mandeville. The traversal is not deemed to be persuasive for the same reasons.

14. Claims 1-2, 5-9 and 22-25 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Huth. The basis of this rejection was stated in Detailed Action § 26-27 of the Office Action of 6/28/02, and has been further discussed in Detailed Action § 18 of the Office Action of 2/28/03, and the Advisory Action of 8/13/03.

15. Applicant also traverses this rejection on the same basis as is discussed above for the rejections over Mandeville and Bister. The traversal is not deemed to be persuasive for the same reasons.

#### ***Art of Interest/Technological Background***

16. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. As previously discussed, Warren and Iwasaki disclose or make obvious MATPAC butyl acrylate copolymers and could also be used in rejecting the instant claims. Iyer, Trouve disclose MATPAC copolymers which could be used in a future rejection of non-elected species of the invention. Additionally, Matz discloses copolymers of MATPAC and alkyl acrylates which are used in paper making and could also be used in a future rejection of the instant claims.

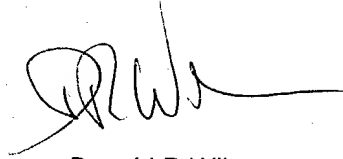
17. Newly cited Yoshimura, not prior art, is cited of interest due to its disclosure of cationic polymers useful in making inkjet recording sheets, which read on the instant claims.

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***Future Correspondence***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald R Wilson whose telephone number is 571-272-1113.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on 571-272-1114. The fax phone numbers for the organization where this application or proceeding is assigned is (703) 872-9306 for regular communications. The unofficial direct fax phone number to the Examiner's desk is 571-273-1113.

A handwritten signature in black ink, appearing to read 'DRW', with a long horizontal line extending to the right.

Donald R Wilson  
Primary Examiner  
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